

REMARKS

This paper is responsive to the Office Action mailed October 20, 2010 (hereinafter "Office Action"). Applicant would like to thank the Examiner for a timely and thorough review of the above-referenced patent application. It is respectfully submitted that in light of the remarks below, all of the claims are now in condition for allowance.

Applicant amends claim 37 to provide a missing "and". No new matter is added and the scope of the claim has not changed.

Nonstatutory Double Patenting

Claims 37-42, 43-48, 49-54, 55 and 56 were provisionally rejected on the ground of nonstatutory double patenting over U.S. Patent No. 6,751,198. The rejection is respectfully traversed. However, Applicant remains prepared to submit a timely and proper terminal disclaimer when this rejection is the only remaining rejection of the claims.

Rejection of Claims 37-58 under 35 U.S.C. § 103(a) – Larson & Nitadori

Claims 37-58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,630,259 to Larson et al. (hereinafter "Larson") in view of U.S. Patent No. 5,875,183 to Nitadori (hereinafter "Nitadori"). Applicant respectfully traverses.

When rejecting a claim under § 103, the Patent Office must either show that the prior art references teach or suggest all limitations of the claim or explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418, 82 U.S.P.Q.2d (BNA) 1385 (2007). The gap between the prior art and the claimed invention may not be "so great as to render the [claim] nonobvious to one reasonably skilled in the art." *Dann v. Johnston*, 425 U.S. 219, 230, 189 U.S.P.Q.(BNA) 257, 261 (1976). In this case, the Patent Office has failed to show where each and every limitation of the claims is taught or suggested by the prior art. Further, for those limitations of the claims that are not taught or suggested by the prior art, the Patent Office has failed to explain why those limitations would have been obvious to one of ordinary skill in the art.

Applicant notes that this is not the first time that the Patent Office has tried to reject the claims over Larson. Applicant refers the Patent Office to the persuasive arguments set forth in

the response filed January 28, 2008 for explanations of portions of Larson not currently cited, but relevant to the discussion of the timer.

Claim 37 recites “a timer; and a processor operable for setting a transmit bit in an outgoing packet to a network and starting the timer when the transmit bit is set, and for reading a receive bit in a received packet from the network and stopping the timer when the receive bit is read, and for monitoring a delay time of the network.” The Patent Office identifies Larson element 531 as the timer and Larson element 149 as the processor (Office Action of October 20, 2010, p.3, ll. 30-31). The claim recites that the processor is operable for starting the timer. Under the Patent Office’s interpretation, that would require control processor 149 to start the timer 531. However, it is readily apparent that this interpretation is demonstrably false. Switching node 101-15 reports to control processor 149 when the node 101-15 has discarded a packet (see Larson, col. 3, ll. 5-10; col. 3, l. 68 through col. 4, l. 4; and col. 4, ll. 13-16), but control processor 149 does not provide any instructions to the timer 531. Thus, the Patent Office’s asserted interpretation of the reference fails to show a first element of the claim.

Applicant notes that switching node 101-15 also has a controller 604. However, neither element 149 nor element 604 “is operable for setting a transmit bit in an outgoing packet....” The Patent Office asserts that Larson teaches the claim element at col. 5, lines 25-30 and col. 5, lines 50-57. However, an examination of the passages again shows that Larson does not support the Patent Office’s assertion. In col. 5, lines 25-30, shift register 600 is used to detect the start bit, and controller 604 is responsive to detection of the start bit to transmit the start timer signal, but neither the shift register 600, the control processor 149, nor the controller 604 “is operable for setting a transmit bit in an outgoing packet” as recited in claim 37. Col. 5, lines 50-57 indicate that the controller 604 is responsive to a timeout signal from timer 531 to determine if the cable 140 is idle. If the signal is present, controller 604 extracts the source and destination fields, but there is no teaching or suggestion that controller 604 or control processor 149 is operable for setting a transmit bit in an outgoing packet. Thus, this element is not taught or suggested by Larson. The Patent Office points to nothing in Nitadori that remedies this deficiency. Since the references individually do not teach or suggest the claim element, the combination of references cannot establish obviousness.

Claim 37 further recites that the processor is operable for “reading a receive bit in a received packet....” The Patent Office asserts that this element is taught by Larson, col. 6, lines

22-25. While the cited passage does say that the controller 604 is responsive to the grant signal to stop transmitting the start timer signal, the passage does not indicate that the control processor 149 reads a receive bit, nor does the passage indicate that the controller 604 reads a receive bit within the grant signal. The Patent Office points to nothing in Nitadori that cures this deficiency. Since the references individually do not teach or suggest the claim element, the combination does not teach or suggest the claim element. Thus, claim 37 is allowable.

Claims 38-42 and 58 depend from claim 37 and are allowable at least for the same reasons.

Claim 43 recites, in relevant part, similar claim elements. The Patent Office relies on the same analysis. Thus, as explained above, the Patent Office has not established obviousness for claim 43. Claims 44-48 depend from allowable claim 43 and are allowable at least for the same reasons.

Claim 49 recites, in relevant part, similar claim elements. The Patent Office relies on the same analysis. Thus, as explained above, the Patent Office has not established obviousness for claim 49. Claims 50-54 depend from allowable claim 49 and are allowable at least for the same reasons.

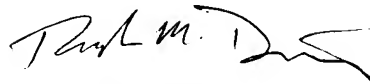
Claim 55 recites, in relevant part, similar claim elements. The Patent Office relies on the same analysis. Thus, as explained above, the Patent Office has not established obviousness for claim 55. Claims 56 and 57 depend from allowable claim 55 and are allowable at least for the same reasons.

Conclusion

In view of the foregoing remarks, Applicant respectfully submits that claims 37-58 of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. Examiner Jain is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

No fees are believed due in connection with this Reply. However, the Office is authorized to charge any fees that may be necessitated by this Reply to Deposit Account No. 50-1732.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Taylor M. Davenport". The signature is fluid and cursive, with a large, stylized "T" and "D".

Taylor M. Davenport
Registration No. 42,466
Withrow & Terranova, PLLC
100 Regency Forest Drive, Suite 160
Cary, NC 27518
919-238-2300

Date: December 29, 2010